

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
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Kwasi ASARE, et al.	:	Confirmation Number: 3074
	:	
Application No.: 10/725,728	:	Group Art Unit: 2191
	:	
Filed: December 2, 2003	:	Examiner: A. Khatri
	:	
For: SCRIPT GENERATION ENGINE AND MAPPING SEMANTIC MODELS FOR TARGET PLATFORM	:	

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The following remarks are submitted in response to the Notification of Non-Compliant Appeal Brief dated March 13, 2008 (hereinafter the First Notice).

REMARKS

On page 2 of the First Notice, the following was stated:

The summary of claimed subject matter fails to separately refer each independent claim (1, 5, 8 and 13) to the specification by page and line number. The independent claims should not be grouped together.

For ease of reference, 37 C.F.R. § 41.37(c)(1)(v), which describes the requirements for the Summary of Claimed Subject Matter section of the Appeal Brief, is reproduced below:

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

This subsection includes two sentences, and notably, the second sentence (i.e., starting "[f]or each independent claim ...") refers to claims that include "means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph." However, none of the claims (either independent or dependent) argued separately in the Argument section of the Appeal Brief include claim language described in the sixth paragraph of 35 U.S.C. § 112. Thus, only the first sentence (i.e., the underlined sentence) of 37 C.F.R. § 41.37(c)(1)(v) applies to the present Appeal Brief.

Since only the first sentence of 37 C.F.R. § 41.37(c)(1)(v) applies to the present Appeal Brief, what is required of the Summary of Claimed Subject Matter section of the Appeal Brief is: (i) a concise explanation of the subject matter in each of the independent claims and (ii) the concise explanation refers to the specification and to the drawings. Referring to the present Application, claims 1, 5, 8, and 13 are independent. Referring to the last full paragraph on page

2 of the Appeal Brief, independent claim 1 was concisely explained; referring to the paragraph spanning pages 2 and 3 of the Appeal Brief, independent claim 5 was concisely explained; and referring to the first full paragraph on page 3 of the Appeal Brief, independent claims 8 and 13 were concisely explained. Moreover, each of the concise explanations included several references to the specification by paragraph number and to the drawings by reference characters. Thus, Appellants submit that the Appeal Brief meets the requirements of 37 C.F.R. § 41.37(c)(1)(v).

Referring to the above-reproduced passage found on page 2 of the First Notice, it is stated that "[t]he independent claims should not be grouped together." Appellants disagree with this statement and note that this statement is without legal basis. Appellants respectfully submit that there is nothing in 37 C.F.R. § 41.37(c)(1)(v) that prevents independent claims 8 and 13 from being concisely explained together (i.e., grouped).

By comparison, attention is directed to 37 C.F.R. § 1.104(c), which reads:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (emphasis added)

Appellants have referred to 37 C.F.R. § 1.104 since this Rule governs the content of an Examiner's Action. Of note is the requirement that "each rejected claim [be] specified." Referring to page 6 of the Third Office Action, the Examiner did not separately refer to independent claims 8 and 13. Instead, the Examiner argued together (i.e., grouped) independent claims 8 and 13. This practice of arguing together nearly identical claims is ubiquitous

throughout the Patent Office. This practice is ubiquitous because repeating, word-for-word, identical rejections is simply wasteful.

Referring again to 37 C.F.R. § 41.37(c)(1)(v), which requires "[a] concise explanation of the subject matter defined in each of the independent claims involved in the appeal," Appellants submit that both this requirement and the requirement in 37 C.F.R. § 1.104(c) require only that each claim be specified and not that each claim be *separately* specified, as asserted in the First Notice. Appellants are unclear as to the difference between the requirements set forth in to 37 C.F.R. § 1.104(c) and the requirements set forth in 37 C.F.R. § 41.37(c)(1)(v) that permits an Examiner to argue similar independent claims together yet allegedly prevents Appellants from concisely explaining similar independent claims together.

If a subsequent Notification of Non-Compliant Appeal Brief is to be issued, Appellants respectfully request a detailed explanation as to why it is believed that 37 C.F.R. § 41.37(c)(1)(v) requires nearly identical independent claims be *separately* concisely explained in the Summary of Claimed Subject Matter section of the Appeal Brief.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: March 17, 2008

Respectfully submitted,

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CUSTOMER NUMBER 46320